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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,386	05/16/2002	Martin Sagasser	DEBE:005US	2267
32425	7590	07/19/2006	EXAMINER	
FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701			KALLIS, RUSSELL	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/030,386	Applicant(s) SAGASSER ET AL.	
	Examiner Russell Kallis	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20,22,23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-12,23 and 28 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 is/are allowed.
- 6) ☒ Claim(s) 13-18,20,22,25-27,29 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/15/06</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's traversal that SEQ ID NO: 2 should be included with SEQ ID NO: 4 because they are structurally similar is acknowledged and SEQ ID NO: 2 and 4 will be examined together as genomic and cDNA.

Claims 1-20, 22-23 and 25-30 are pending. Claims 1-12, 23 and 28 are withdrawn. Claim 24 has been cancelled. Claims 13-20, 22, 25-27 and 29-30 are examined.

Rejection of Claims 13-18, 21 and 29-30 under 35 U.S.C. 112, second paragraph, is withdrawn in view of Applicant's amendments.

Rejection of Claim 26 under 35 U.S.C. 101 is withdrawn in view of Applicant's amendments.

Rejection of Claims 13-18, 20-22, 24-27 and 29-30 under 35 U.S.C. 102(b) is withdrawn in view of Applicant's amendments.

Rejection of Claim 19 under 35 U.S.C. 102(b) is withdrawn in view of Applicant's amendments.

### ***Claim Objections***

Claim 13 is objected to because of the following informalities: The spelling of homologue is inconsistent with the use of homolog throughout the remaining claims.

Appropriate correction is required. Amending to one or the other is suggested.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a NEW MATTER rejection.

The added claimed material which is not supported by the original disclosure is as follows: Newly amended Claim 15 recites “a nucleic acid sequence that encodes a ribozyme that targets expression of a protein encoded by SEQ ID NO: 2 or 4”. There is no support in the specification for a nucleic acid sequence that encodes a ribozyme that targets expression of a protein encoded by SEQ ID NO: 2 or 4. Applicant is invited to point to the page and line number in the specification where support can be found. Absent of such support, Applicant is required to cancel the new matter in the reply to this Office Action.

Claims 13-18, 20, 22, 25-27 and 29-30 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is maintained for the reasons of record set

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forth in the Official action mailed 7/27/2005. Applicant's arguments filed 4/28/2006 have been considered but are not deemed persuasive.

Applicant asserts that they have met the two prong test of *Lily* and have provided a great deal of information about homologues (response page 11). Applicant has not defined the biological activity associated with the claimed genus of sequences that encompasses portions of either SEQ ID NO: 2 or 4 that would hybridize with some unspecified homologous sequence. The common structural elements are not defined by hybridization because the specification defines hybridization conditions that would encompass stringent hybridization conditions that are less than the example provided in the specification. Furthermore, a nucleic acid sequence encoding a ribozyme that targets SEQ ID NO: 2 or 4 is not described as well.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-14, 16-18, 20, 22, 25-27 and 29-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "stringent conditions" in claims 13, 20, 26 and 29 is a relative term which renders the claim indefinite. The term "stringent conditions" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "stringent" could be low or high stringency. Applicants specification presents one example of "stringent conditions" and does not set forth an upper or lower threshold for that stringency; and thus the claims are indefinite

***Claim Rejections - 35 USC § 102***

Claims 13-18, 20, 22, 25-27 and 29-30 remain rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/00501 published 7 January 1999.

Applicant asserts that there is no relationship between the amino acid comparison of TT1 and TTG1 shows a 0% match (response page 13). Applicant is arguing limitations that are not in the claim because the claim is drawn to nucleic acid sequence and not amino acids as argued. Moreover, the claims are indefinite as argued supra. The specification does not set forth any reasonable boundary for stringent conditions. Further, Applicants arguments that the TTG1 from *Arabidopsis* has a function distinct from TT1 is incorrect since the applied art reference clearly shows that TTG1 is involved in anthocyanin biosynthesis. Further, the requirement for hybridization is not hybridization of the entire TT1 nucleic acid sequence but rather only an unspecified portion of the TT1 sequence.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claims 13-18, 20, 22, 25-27 and 29-30 remain rejected.

Claim 19 is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (571) 272-0798. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Russell Kallis Ph.D.  
July 10, 2006

RUSSELL P. KALLIS, PH.D.  
PRIMARY EXAMINER

*Russell Kallis*